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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,286	07/07/2000	Julio A. Abusleme	108910-00011	8395

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EXAMINER
SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
1714	11

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-11

Advisory Action	Application No. 09/612,286	Applicant(s) ABUSLEME ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attachment*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-10*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Attachment to Advisory Action

1. Applicants amendment filed 7/30/02 has been fully considered, but it has not been entered given that it raises new issues under 35 USC 112, second paragraph.

Specifically, if the amendment were entered, claim 3, would depend on a cancelled claim, namely, claim 2. Further, claim 8, which depends on claim 1, recites the limitation "the reaction medium" in line 1. There is insufficient antecedent basis for this limitation in the claim given that there is no disclosure of "reaction medium" in claim 1.

Further, it is noted that even if the amendment were entered, the present claims would not be allowable over the "closest" prior art Absuleme et al. (U.S. 5,498,680) which is used to reject the claims under 35 ~~USC (b)~~ 102.

Applicants argue that Absuleme et al. is not a relevant reference against the present claims given that there is no disclosure in Absuleme et al. of combination of specific fluorinated surfactant and initiator as presently claimed. Applicants argue that Absuleme et al. disclose that the initiator is indifferently selected from list of initiators while fluorinated surfactant is indifferently selected from list of surfactants.

However, it is noted that "when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named", *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Further, it is noted that the choice of each of the claimed initiator and surfactant is not made from a long list. Thus, given that Absuleme et al. disclose process of synthesizing chlorotrifluoroethylene homopolymer or copolymer wherein the process is conducted in perfluoropolyoxyalkylene microemulsion which comprises perfluoropolyoxyalkylene surfactant identical to those presently claimed in the presence of alkali

metal persulfate initiator, it is clear that Absuleme et al. meets the limitations of the present claims.

It is noted that Abusleme et al. disclose the use of initiators which include alkali metal persulfates and ammonium persulfates. The comparative data in the present specification compares invention within the scope of the present claims, i.e. utilizing potassium persulfate (example 1), with invention outside the scope of the present claims, i.e. comprising ammonium persulfate (example 5). It is shown that the process of the present invention produces chlorotrifluoroethylene polymer with no discoloration while the comparative process produces a chlorotrifluoroethylene polymer which is discolored.

However, it is noted that the present claims are not rejected as being obvious over the cited art, but rather are anticipated over the prior art. Given that Abusleme et al. already disclose the use of initiator as presently claimed, the results of the comparison in the declaration are not believed to be unexpected or surprising.

Additionally, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), such as Abusleme et al., can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

Callie Shosho
8/12/02

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